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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/985,856	11/06/2001	Hidenori Mukaida	Q67030	4383

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EXAMINER

HSIEH, SHIH YUNG

ART UNIT PAPER NUMBER

2837

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/985,856

Applicant(s)

MUKAIDA, HIDENORI

Examiner

Shih-yung Hsieh

Art Unit

2837

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-8 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 5-8, 12-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 2837

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 5, 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karlsson (WO99/17007) in view of Masuda et al. (5,738,184).

Regarding claim 5, Karlsson disclose an engine muffler comprising: a first expansion chamber (Figs. 3) having a chamber gas inlet aperture connecting to an engine exhaust gas outlet (Fig. 3); a second expansion chamber (Fig. 3) having a chamber gas outlet aperture (the aperture at the end of 11); a first exhaust gas purifier (2) extending between the first and the second expansion chambers (Fig. 3); a first cover plate (18), which has an inlet aperture (19), covering an upstream portion of the first exhaust gas purifier in the first expansion chamber; and a second cover plate (Fig. 3), which has an outlet aperture (the aperture connected to 11), covering a downstream portion of the first exhaust gas purifier in the second expansion chamber.

The difference between Karlsson's muffler and claim 5 is that claim 5 recites a wall of at least one of the first expansion chamber and the second expansion chamber has a double wall construction with a predetermined gap interposed therebetween.

Masuda et al. teach a first expansion chamber having a double wall construction (36, 41) extended to the engine with a heat insulating plate (22) between the engine and the wall to which the engine is installed. It would have been obvious to one having

ordinary skill in the art to modify Karlsson's muffler as taught by Masuda et al. to include a double construction of the first and the second expansion chambers for the purpose of providing heat insulation.

Regarding claim 7, it is obvious that when there is no particular restriction existed in gas purification concentration degree, there is no need to apply a catalyst to the first exhaust gas purifier. The recitation appears to be related to a regulation rather than a structural limitation of an invention, therefore, does not carry any patentable weight.

Regarding claim 8, Karlsson discloses the claimed invention including the first cover plate and the partition are of a monolithic, one piece construction as shown in Fig. 1 except that the second cover plate is fastened to the partition with a bolt and a nut.

Masuda et al. teach fastening a partition plate (40) to the expansion chambers by bolt and nut (45) for being able to take apart. It would have been obvious to one having ordinary skill in the art to modify Karlsson's muffler as taught by Masuda et al. to fasten the second cover plate to the partition with a bolt and a nut for the purpose of being able to take apart.

3. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karlsson in view of Funakoshi et al. (6,250,075) and Fischer et al.

Regarding claims 12 and 14, Karlsson discloses the claimed invention except that a second exhaust gas purifier provided in the first expansion chamber, and has an open end facing the engine exhaust gas outlet; wherein a wall of at least one of the first expansion chamber and the second expansion chamber has a double wall construction

with a predetermined gap interposed therebetween, wherein a heat insulating material is packed in the gap between the double wall..

Funakoshi et al. teach a second exhaust gas purifier (16) provided in the first expansion chamber and has an open end facing the engine exhaust gas outlet (Fig. 2).

Fischer et al. teach the side walls of the second expansion chamber being made of a double wall construction with a predetermined distance, and having a heat insulating material between them. It would have been obvious to one having ordinary skill in the art to modify Karlsson's muffler as taught by Funakoshi et al. and Fischer et al. to include a second exhaust gas purifier in the first expansion chamber, and the side walls of the second expansion chamber being made of a double wall construction with a predetermined distance, and having a heat insulating material between them for the purpose of providing high temperature resistant insulation.

Regarding claim 13 see statement addressed to claim 7.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Karlsson in view of Masuda et al. as applied to claim 5 above, and further in view of Fischer et al. (4,890,690).

Regarding claim 6, Karlsson in view of Masuda et al. disclose the claimed invention except a heat insulating material is provided in the gap between the double wall.

Fischer et al. teach a heat insulating material (32) being provided in the gap between the double wall (29) of a muffler (8). It would have been obvious to one having

ordinary skill in the art to modify Karlsson in view of Masuda et al's muffler as taught by Fischer et al. to include a heat insulating material in the gap between the double wall for the purpose of providing high temperature resistant insulation.

5. Applicant's arguments filed 8/1/2003 have been fully considered but they are not persuasive.

The applicant is reminded that it is the claim language and recited structural limitations that are reviewed for patentability. The features described in the specification and the drawings, not recited in the claims, do not constitute a valid argument against the references. The following features that the applicant argued were different from the prior art were not recited in claims 5, 8, and 12.

In claim 5, the limitation "the insulating material" is not recited in the claim as the applicant argued. The applicant argued that "there are no cover plates 17, 17' in Karlsson. The examiner disagrees because Karlsson does disclose cover plates shown in Fig. 3. Further, Masuda does teach a double wall construction for a muffler. Therefore, the combination of the references read on claim 5.

In claim 8, the limitation "air gaps provided in the upper and lower parts of the second expansion chamber" is not recited in the claim as the applicant argued. Further, Masuda does teach securing the cover plates together with a bolt and a nut. Therefore, the combination of the references read on claim 8.

In claim 12, the function that "the exhaust gas does not go through the structure consisting of the inner wall 12a, 14a, the insulating material 16, and the outer wall 12b,

14b is not recited in the claim as the applicant argued. The applicant is reminded that the claims are reviewed based on the recited structures rather than functional language. Therefore, the combined references read on the claim.

In response to Applicant's argument that it would have been illogical to arrive at the structure of the present invention in view of the combined teachings of the references, the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. In re Bozek, 163 USPQ 545 (CCPA 1969).

For the above reasons, the rejections stand.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shih-yung Hsieh whose telephone number is 703-308-1031. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Nappi can be reached on 703-308-3370. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3431 for regular communications and 703-305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

syh
August 26, 2003



SHIH-YUNG HSIEH
PRIMARY EXAMINER